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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,302	10/22/2003	Douglas M. Dillon	PD-N94026K	2255
20991	7590	12/23/2004		
THE DIRECTV GROUP INC PATENT DOCKET ADMINISTRATION RE/R11/A109 P O BOX 956 EL SEGUNDO, CA 90245-0956			EXAMINER AVELLINO, JOSEPH E	
			ART UNIT 2143	PAPER NUMBER

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,302

Applicant(s)

DILLON, DOUGLAS M.

Examiner

Joseph E. Avellino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 1003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/22/2003
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 20-32 are presented for examination.

Priority

2. Applicants request for priority under 35 U.S.C. 120 is granted.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 20-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. application No. 09/559/118 (the parent case). Although the conflicting claims are not identical, they are not patentably distinct from each other because the parent case claims a driver receiving an IP packet from a TCP/IP stack, rather than a driver for sending a packet using a TCP/IP stack. For the driver of the parent case to be able to receive a packet

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using the claimed driver, the packet must be sent from a driver using a TCP/IP stack, which is the currently claimed invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Dawson et al. (USPN 5,594,490) (cited by Applicant in IDS) (hereinafter Dawson).

6. Referring to claim 20, Dawson discloses a driver (i.e. software) for use in a computing device (i.e. stations) having a TCP/IP stack, said driver being configured to send an IP packet from the TCP/IP stack through an IP tunnel (the term IP tunnel can be taken as encapsulating or encoding a packet into an IP packet for use on an IP network) across a network (e.g. abstract; col. 8, lines 48-67).

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7. Referring to claim 21, Dawson discloses the network is the internet (col. 7, lines 36-67).
8. Referring to claim 22, Dawson discloses an apparatus on the network receives the IP packet through the IP tunnel (col. 7, line 50 to col. 8, line 64).
9. Referring to claim 23, Dawson discloses the apparatus on the network sends the received IP packet towards its destination via a network (i.e. PSTN) (Figure 2; col. 8, line 57 to col. 9, line 59).
10. Referring to claim 24, Dawson discloses an internet browser running on the computing device accesses a server through the TCP/IP stack of the computing device which sends a request to the server by way of said driver and the apparatus on the network (e.g. abstract; col. 12, lines 41-55).
11. Referring to claims 25 and 26, Dawson discloses the computing device is a personal computer (i.e. RS 39, such as a Dell 486/66 EISA, a well known Personal Computer) (col. 9, lines 28-42).
12. Referring to claim 27, Dawson discloses said driver interfaces to the TCP/IP stack using an Ethernet device driver interface (col. 6, lines 23-30).

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13. Referring to claim 28, Dawson discloses the driver interfaces to the TCP/IP stack of the computing device using a network driver interface specification (it is inherent that communications software running on a TCP/IP network would require a specification in order to communicate with the stack since this is the only way a driver can interface with a communications protocol).

14. Claims 29-32 are rejected for similar reasons as stated above.

Claims 20-32 are rejected under 35 U.S.C. 102(e) as being anticipated by DirecPC (Hughes Network Systems, Phase A Data Sheet, dated June 7, 1993, pp. 5-8) (cited by applicant in IDS) (hereinafter DirecPC).

15. Referring to claim 20, DirecPC discloses a driver (i.e. software) for use in a computing device (i.e. stations) having a TCP/IP stack, said driver being configured to send an IP packet from the TCP/IP stack through an IP tunnel (the term IP tunnel can be taken as encapsulating or encoding a packet into an IP packet for use on an IP network) across a network (p. 5, section 1).

16. Referring to claim 21, DirecPC discloses the network is the internet (Figure on page 5).

17. Referring to claim 22, DirecPC discloses an apparatus on the network receives the IP packet through the IP tunnel (p. 5, section 1).

18. Referring to claim 23, DirecPC discloses the apparatus on the network sends the received IP packet towards its destination via a network (i.e. satellite) (Figure on page 5).

19. Referring to claim 24, DirecPC discloses an internet browser running on the computing device accesses a server through the TCP/IP stack of the computing device which sends a request to the server by way of said driver and the apparatus on the network (first paragraph on page 5).

20. Referring to claims 25 and 26, DirecPC discloses the computing device is a personal computer (p. 5).

21. Referring to claim 27, DirecPC discloses said driver interfaces to the TCP/IP stack using an Ethernet device driver interface (p. 8, section 5).

22. Referring to claim 28, DirecPC discloses the driver interfaces to the TCP/IP stack of the computing device using a network driver interface specification (it is inherent that communications software running on a TCP/IP network would require a specification in

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order to communicate with the stack since this is the only way a driver can interface with a communications protocol.

23. Claims 29-32 are rejected for similar reasons as stated above.

Claims 20, 22, 23, and 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Perkins (USPN 5,159,592) (cited by applicant in IDS).

24. Referring to claim 20, Perkins discloses a driver (i.e. software) for use in a computing device (i.e. mobile unit 10) having a TCP/IP stack (col. 4, lines 12-20), said driver being configured to send an IP packet from the TCP/IP stack through an IP tunnel (the term IP tunnel can be taken as encapsulating a packet into an IP packet for use on an IP network) across a network (col. 7, line 67 to col. 8, line 14).

25. Referring to claim 22, Perkins discloses an apparatus (i.e. local or global gateways) on the network receives the IP packet through the IP tunnel (col. 7, lines 54-66).

26. Referring to claim 23, Perkins discloses the apparatus on the network sends the received IP packet towards its destination via a network (col. 7, lines 54-66).

27. Referring to claim 28, Perkins discloses the driver interfaces to the TCP/IP stack of the computing device using a network driver interface specification (it is inherent that communications software running on a TCP/IP network would require a specification in order to communicate with the stack since this is the only way a driver can interface with a communications protocol).

28. Claims 29-32 are rejected for similar reasons as stated above.

Claims 20-23, and 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson, Jr. (USPN 5,640,504) (hereinafter Johnson).

29. Referring to claim 20, Johnson discloses a driver (i.e. software) for use in a computing device (i.e. node) having a TCP/IP stack, said driver being configured to send an IP packet from the TCP/IP stack through an IP tunnel (the term IP tunnel can be taken as encapsulating a packet into an IP packet for use on an IP network) across a network (col. 26, lines 23-40).

30. Referring to claim 21, Johnson discloses the network is the Internet (i.e. internetwork (col. 26, lines 1-13)).

31. Referring to claim 22, Johnson discloses an apparatus on the network receives the IP packet through the IP tunnel (col. 26, lines 1-54).

32. Referring to claim 23, Johnson discloses the apparatus on the network sends the received IP packet towards its destination via a network (col. 26, lines 1-54).

33. Referring to claim 27, Johnson discloses said driver interfaces to the TCP/IP stack of the computing device using an Ethernet device driver interface (col. 4, lines 43-63; col. 6, line 64 to col. 7, line 10).

34. Referring to claim 28, Perkins discloses the driver interfaces to the TCP/IP stack of the computing device using a network driver interface specification (it is inherent that communications software running on a TCP/IP network would require a specification in order to communicate with the stack since this is the only way a driver can interface with a communications protocol).

35. Claims 29-32 are rejected for similar reasons as stated above.

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

37. Pettus (USPN 5,548,723) discloses OO network protocol configuration.

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38. Howarter et al. (USPN 5,280,625) discloses linking data terminals and their host computers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA
December 6, 2004

William C. Vaughn
Primary Examiner
Art Unit 2143
William C. Vaughn, Jr.